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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/580,591	05/26/2000	Robert A. Levy	11819-002001	9499
22832	7590	06/03/2004	EXAMINER	
KIRKPATRICK & LOCKHART LLP			WON, MICHAEL YOUNG	
75 STATE STREET			ART UNIT	
BOSTON, MA 02109-1808			PAPER NUMBER	
2155				
DATE MAILED: 06/03/2004				

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/580,591	LEVY, ROBERT A.4
	<b>Examiner</b>	<b>Art Unit</b>
	Young N Won	2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### **Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 24 March 2004.

2a)  This action is **FINAL**.                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1-35 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-35 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a))

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date .

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_ .

5)  Notice of Informal Patent Application (PTO-152)

6)  Other: \_\_\_\_\_

## DETAILED ACTION

1. Claims 1, 2, 10-1317, 20, 21, 28-31, and 34 have been amended. Claims 1-35 have been re-examined and are pending with this action.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-15, 17-24, and 26-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Skinner et al. (US 5963914A) in view of Paizis (us 6338042 B1).

As per claims 1, 11, 12, 21, 28, 30, 32, and 34, Skinner teaches of a system, a method, and an apparatus comprising a computer-readable medium or memory that stores computer instructions and a processor (see col.9, line 52) that executes the computer instructions for implementing an application for obtaining information (see abstract: "data collector") about the work activities (see abstract: "time and work performed") of a plurality of employees (see col.3, lines 4-6), comprising: a server for providing a site through which each of the plurality of employees creates a profile of the work activities of the employee (see col.20, lines 35-45); and a computer capable of

accessing the site over a network, each of the plurality of employees using the computer to create the profile of the work activities of the employee, and transmit the information about the work activities of the employee to the server (see col.2, lines 43-54 and line 67 to col.3, line 3).

Skinner does not explicitly teach wherein the server calculates a market valuation for the profile of the work activities of the employee including by correlating the work activities of the employees, percentages of time allocated to the work activities of the employees, and salary rates. Paizis teaches of calculating a market valuation for the profile of the work activities of the employee (see col.4, lines 10-16) including by correlating the work activities of the employees (see col.4, lines 16-19: "level of contribution" used to "rank the individual"), percentages of time allocated to the work activities of the employees (see col.4, lines 22-24: "level of contribution"), and salary rates ("appropriate pay levels").

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the teachings of Paizis with the system of Skinner by implementing calculating market valuation within the work activity information obtaining system, method and apparatus because Paizis teaches that performance is evaluated (see col.1, line 54 to col.2, line 7) and Skinner teaches that "the system is useful as an objective tool for... performance-based assessment testing (see col.19, lines 17-23).

As per claim 2, Skinner does not explicitly teach wherein the server is capable of performing an analysis of the work activities of the employee based on the profile of the work activities of the employee and the calculated market valuation. Paizis teaches of

performing an analysis of the work activities of the employee based on the profile of the work activities of the employee and the calculated market valuation (see col.4, lines 10-16). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the teachings of Paizis with the system of Skinner by implementing calculating market valuation within the work activity information obtaining system, method and apparatus because Paizis teaches that performance is evaluated (see col.1, line 54 to col.2, line 7) and Skinner teaches that "the system is useful as an objective tool for... performance-based assessment testing (see col.19, lines 17-23).

As per claims 3, 13, 22, 29, 31, 33, and 35, Skinner further teaches wherein the server is capable of generating a report based on the work activities of the employee in the profile. Although Skinner does not explicitly teach that the generated report is based on calculated market valuation for the profile or analysis, such would be implicit according to employing the teachings of Paizis (see claim 2 rejection above and col.4, lines 54-61).

As per claim 4, Skinner further teaches wherein the network is a network known as the Internet (see col.5, lines 36-37).

As per claims 5 and 6, Skinner teaches of further comprising a database (see Fig.1, #106 and col.4, lines 61-67) including work activity values for work activities of the employee in the profile and a database including a directory of work activities used to create the profile (see col.4, lines 24-51 and col.5, lines 1-10). (**Note:** By employing another database does not necessitate an invention, for optimization, databases are added or replaced with larger databases, according to memory requirements and cost,

and the allocation of data within that database can be segmented as desired, therefore the addition of another database does not change the functionality of the claimed invention.)

As per claim 7, Skinner further teaches wherein the profile contains a plurality of groups of work activities (see col.3, lines 49-56 and col.4, lines 29-32).

As per claims 8, 19, and 27, Skinner further teaches wherein the employee assigns a percentage of the employee's time to each group of work activities in the profile (see col.1, lines 38-40; col.4, lines 39-43; and col.16, line 46 to col.17, line 20).

As per claim 9, Skinner further teaches wherein a work activities group value is calculated for each group of work activities (see col.3, lines 14-18 and col.5, lines 54-57).

As per claims 14, 15, 23 and 24, Skinner teaches of further comprising adding and deleting work activities of the employee to the profile (see col.3, lines 37-18 & lines 49-53 and col.4, lines 40-41).

As per claims 19 and 26, Skinner teaches of further comprising, assessing a capability of the employee with respect to the work activities in the profile (see col.2, lines 3-4 & lines 57-62).

As per claims 10 and 20, Skinner does not explicitly teach wherein the work activities group values for the groups of work activities are weighted to calculate the market valuation for the profile. Paizis teaches of calculating market valuation that is weighted (see col.5, lines 43-47 and col.5, line 65 to col.6, line 2). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to

employ the teachings of Paizis within the system of Skinner by implementing calculating a market valuation that is weighted values within the work activities obtaining method because Paizis teaches that there are other factors such as "competency" that more accurately determines performance ranking.

As per claim 17, Skinner does not explicitly teach of further comprising, converting the market valuation for the profile to a local geographic equivalent value. Paizis teaches of converting market valuation for the profile to a local geographic equivalent value (see col.5, lines 43-47). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the teachings of Paizis within the system of Skinner by implementing calculating a market valuation that is weighted values within the work activities obtaining method because Paizis teaches that there are other factors such as "external market distribution data" that more accurately determines performance ranking.

3. Claims 16 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Skinner et al. (US 5963914A) and Paizis (US 6338042 B1), and further in view of Homan et al. (US 6275570 B1).

As per claims 16 and 25, Skinner and Paizis do not teach of further comprising providing a template for the employee to create the profile. Homan teaches providing a template for creating a profile (see col.6, lines 49-54). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the teachings of Homan within the system of Skinner and Paizis by implementing a

template for creating a profile within the work activities obtaining method because Homan teaches that with the use of a template, the server can create an appropriate SMTP address for the subscriber (user or employee) (see col.6, lines 54-57) to allow an administrator to construct information pertaining to the subscriber in the database (see col.6, lines 38-48).

### ***Response to Arguments***

4. Applicant's arguments filed March 24, 2004 have been fully considered but are not persuasive because Paizis (US 6338042 B1) teaches the amended claim limitation of "market valuation". Skinner et al. (US 5963914A), Paizis (US 6338042 B1), and Homan et al. (US 6275570 B1) clearly teach all the elements of the claims recited.

In regards to the disagreement regarding the amendment incorporating elements of the market valuation, although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Therefore, the element of the market valuation clearly changes the scope of the claimed invention.

Applicant's arguments with respect to claims 1-35 have been considered but are moot in view of the new ground(s) of rejection.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Young N Won whose telephone number is 703-605-4241. The examiner can normally be reached on M-Th: 6AM-3PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain T Alam can be reached on 703-308-6662. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Young N Won



May 25, 2004



HOSAIN ALAM  
SUPERVISORY PATENT EXAMINER